•• REMARKS/ARGUMENTS ••

The Official Action of March 31, 2004 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

On page 2 of the Official Action the Examiner has rejected claims 4 and 5 under 35 U.S.C. §112 second paragraph. Under this rejection the Examiner states that claims 4 and 5 are indefinite for reciting only the desired physical properties of the continuous fibers and the breathable liquid-impervious sheet, rather than setting forth structural and/or chemical characteristics of the materials.

The Examiner's position is respectfully in error, because claims 4 and 5 only recite the relative breathabilities of the layers of the continuous second thermoplastic synthetic fibers and the breathable liquid-impervious sheet.

The Examiner's reliance upon *Ex parte Slob*, 157 USPQ 172 (TOP Bd App 1967) is not applicable to the present situation. The Examiner will note in *Slob*, the Board of Appeals held that claim recitations such as "a liquefied substance...being compatible with the ingredients in the powdered detergent composition" were indefinite because they encompassed everything that will perform the desired functions.

Applicants' claims 4 and 5 only recite the relative breathabilities of the layers of the continuous second thermoplastic synthetic fibers and the breathable liquid-impervious sheet.

There is no basis to compare and apply the holding in *Slob* to applicants' claims 4 and 5.

Claims 1 and 6-10 stand rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,286,145 to Welchel et al.

Welchel et al. has a filing date of December 22, 1999.

The present application enjoys a foreign priority date of July 12, 1999 which is earlier than then the filing date of Welchel et al.

Accordingly, Welchel et al. is not available as a prior art reference against the present application.

Included with applicants' first submission to the U.S. Patent and Trademark Office was a copy of applicants' Notification Concerning Submission of Transmittal of Priority Document which indicates receipt of priority application (JP) No. 11/198218 having a filing date of 12 July 1999.

Moreover, the Examiner previously acknowledged receipt of a certified copy of the priority document in the application in the Official Action of August 21, 2003.

Accordingly, it is submitted that the records at the international bureau and the U.S. Patent and Trademark Office establish that that Welchel et al. does not qualify as prior art against the present invention.

It is noted that the Manual of Patent Examining Procedure (MPEP) states in Section 201.15 that:

> If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in English language, to determine if the applicant is entitled to their date. If the

applicant is found to be entitled to the date, the reference is simply not used but cited to applicant on form PTO-892.

It is submitted that the drawings in applicants' priority document show all the structural features set forth in applicants' independent claim 1 and do not require any translation.

What is not show in the drawings are the breathability and water resistance properties as that are claimed.

However, the Examiner concedes that Welchel et al. does not teach the claimed breathability and water resistance.

Accordingly, by the Examiner's own admission, Welchel et al. does teach applicants' claimed invention and therefore Welchel ct al. is not available as a reference against the present application.

The Examiner has cited *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980) as supporting her position with regard to reliance upon Welchel et al. under 35 U.S.C. §103.

In *Fitzgerald* the CCPA interpreted product claims to be product-by-process claims because appellants argued that there was no other way to product the product defined in the appealed claims (other than by appellants' disclosed process).

The products were self-locking screws that included a patch of thermoplastic polymer bonded to the threaded portion of the fasteners.

In U.S. Patent No. 3,830,902 to Barnes (relied upon by the Board of Appeals in *Fitzgerald*) the thermoplastic polymer applied to the fasteners was cooled at ambient temperature whereas appellant quenched the thermoplastic polymer in water and argued that they quenching process caused the thermoplastic polymer to shrink less and therefore bond more tightly to the fasteners.

The CCPA held that the prior art fasteners of Barnes were either identical or only slightly different from appellants' fasteners and placed burden in applicants' to "prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed products."

In the present situation the Examiner has conceded that Welchel et al. does not teach applicants' claimed breathability and water resistance properties.

Applicants do not purport that they have developed a new process for adjusting the breathability and water resistance of fibrous sheets or fibrous layers.

Applicants are only claiming ranges of breathability and water resistance and ratios of these properties within the composite sheet.

There is no "product-by-process" issue in the present situation that invokes the holding in *In re Fitzgerald.*

Accordingly, it is submitted that, even it Welchel et al. were available to the Examiner as a prior art reference (which it is not), Welchel et al. nevertheless fails to teach, anticipate or suggest applicants' claimed invention.

The Examiner's reliance upon *In re Best*, 195 USPQ 102 as supporting a rejection under 35 U.S.C. §102 based upon Welchel et al. is unfounded since the Examiner expressly concedes that Welchel et al. fails to each applicants' claimed breathability and water resistance limitations. Although a detailed discussion of *Best* is not deemed necessary in the present response, it is noted that *Best*, like *Fitzgerald* involves issues related to a process that appellants relied upon to produce a

product (a crystalline zeolite aluminosilicate) that they argued was distinguishable from the prior art because of properties associated with the product.

As noted above, applicants do not purport that they have developed a new process for adjusting the breathability and water resistance of fibrous sheets or fibrous layers.

Applicants are only claiming ranges of breathability and water resistance and ratios of these properties within the composite sheet.

Based upon the above, it is submitted that Welchel et al. is not available to the Examiner as a prior art reference and moreover Welchel et al. nevertheless fails to anticipate applicants' claimed invention under 35 U.S.C. §102 and further fails to render obvious applicants' claimed invention under 35 U.S.C. §103.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

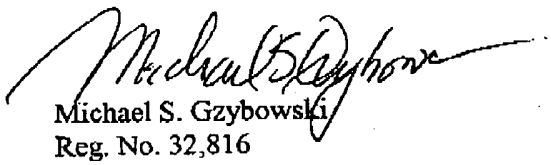
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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